MS No. 150732.1
Attorney Docket No. MCS-119-99
PATENT APPLICATION
USPTO CUSTOMER NUMBER: 27662

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of Greden et al.	: Group Art Unit: 3625
	:
Entitled: A SYSTEM AND METHOD FOR MANAGING AND CONTROLLING ACCOUNTS WITH PROFILE INFORMATION	: Examiner: Rhode, R.
Serial No.: 09/584,232	:
Filing Date: May 31, 2000	:

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This reply brief is responsive to the Examiner's Answer which is marked as being

mailed on October 18, 2005 on the coversheet and is stamped as being mailed on October

31, 2005 on the Examiner's Answer itself.

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1. **Missing Element.**

The Examiner contends on page 3, in response to the Appellant's Appeal Brief arguments that, "In response to Appellant's arguments against the references individually, one cannot show non-obviousness by attacking references individually, where the rejections are based on combinations of references..." As repeatedly pointed out by the Appellant, Burge does not teach automatically providing the identity of a buyer to a suitable agent. Likewise, Rizzo does not teach automatically providing the identity of a buyer to a suitable agent without the agent having to take action. Thus, the combined teachings of these two references also lacks this claimed feature. **The applicants have shown that a claimed element is missing from both references and so is missing from the combination. This does not constitute "attacking the references individually".** Rather, it shows the combined teaching are insufficient to show obviousness. It is also noted that Burge or Rizzo do not recognize the advantages of the aforementioned claimed feature, such as a reduced effort for the agent. Hence, no prima facie case of obviousness has been established in accordance with *In Re Fine*.

Furthermore, the Examiner states, "it is noted that the features upon which Appellant relies (i.e., "manually" and "select") are not cited in the rejected claim(s)." However, the appellant is not arguing that the terms "manually" or "select" make the claims patentable, but uses these to show that the cited art differs from the automatic buyer identity providing feature that is claimed. More particularly, as previously argued by the Appellant, in general, the Appellants' claim a system and method for finding a prospective buyer and automatically providing the identity of the buyer to agents offering for sale products or services. The Appellants' claimed invention provides the buyer with an interactive environment having information relating to the products or services offered by the agents (page 8, lines 13-15). A profile of the buyer is created by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment (page 8, lines 16-24). The profile and the inferred criteria are compared with the criteria of the products or services offered by the agents to match a

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suitable agent with a suitable buyer based on the created inferred profile of the buyer (page 8, line 25-28). The identity of the suitable buyer is automatically provided to the suitable agent (page 8, line 28 through page 9, line 5).

As repeatedly pointed out by the Appellant, Burge does not teach automatically providing the identity of a buyer to a suitable agent. Likewise, Rizzo does not teach providing the identity of a buyer to a suitable agent without the agent having to take a series of actions. Specifically, Rizzo teaches a computerized method for matching potential clients with professional services providers which meet the buyer's specified criteria. The Rizzo system is set up for a client in need of attorney services. Hence, when the data entered by the client is sent out to one or more suitable attorneys only part of the client's information is provided. **The client's identity that would allow direct contact (name, email and phone number) is not provided (Figure 1 a, step 270). In order to retrieve the client's identity the attorney must go to a website and make a specific request to retrieve it (Figure 1 a, step 290).** Clearly, Rizzo does not provide the client's identity to the attorney without the need for the attorney to perform manual actions. <u>**This is intentional so as to provide a means for the attorney to preclude conflicts in representing clients.**</u>

Granted, the Examiner argues that Burge does disclose online purchasing whereby the identity of the buyer is disclosed the seller, and that in online purchasing the identity of the online shopper/buyer is revealed to the seller/merchant. Clearly this is not the automatic feature claimed by the Appellant. The Examiner further alleges that the facts are not disputed by the Appellant. However, this is not the case. As stated in the After Final Response, "**Burge merely displays certain items to the buyer based on the buyer's past preferences. No seller's criteria are used to match a buyer to a seller and provide the seller the buyer's identity. Burge does not provide the identity of a suitable buyer to a suitable agent.** In Burge it is impossible for the seller to obtain the buyer's identity...**Nowhere do the cited passages state that the identity of the buyer is provided to the seller.** <u>**The seller's products are merely displayed to the buyer based on the buyer's shopping**</u>

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preferences based on a predictive model. The agent cannot directly contact the buyer because the buyer's identity is not known." The Examiner argues that, "In purchasing a product online, it well known that the seller would obtain the identity of the buyer with the input of the name and credit number of the buyer. " **But Burge merely customizes the display of prospective buyers. The credit card number and name of the buyer are not available for prospective buyers because no sale has been made.**

The Examiner further argues that Appellant did not define "identity". The Examiner states that identity is defined as "a characteristic that identifies the buyer through generic characteristic such as a file/message identified for example with a case ID and a short description of their individual needs." However, even if for argument's sake this definition of identity is said to be applicable, it is not sufficient to allow an agent to directly contact a buyer as previously argued by the Appellant. The Examiner states that Rizzo teaches a method and system for automatically providing the identity of the suitable buyer to the suitable agent without action from the agent at Col. 1, lines 54-57, Col. 4, lines 12-21 and FIGs. 4 and 5   However, FIG. 4 and FIG. 5 merely show a system-assigned case ID, password, and user-entered case information that does not include the buyer's identity such as name or other information that would allow an attorney to know who the user is so that he or she could contact them directly without going through the system. The cited passages state,

> "A computerized method for matching potential clients with professional services providers which meet their personalized criteria and are interested in providing particular services to them including the steps of: presenting a first electronic document including a plurality of data entry devices to the potential clients via a computer network; receiving data entered using the data entry devices, **the received data being indicative of the criteria**; automatically comparing the received data to data stored in a storage medium to identify one or more suitable professional services providers; automatically generating and transmitting via the computerized network an electronic mail message to the identified one or more service providers, the electronic **message including information indicative of a portion of the received data**; and, receiving a response from at least one responding one of the one or more identified service providers, and **automatically providing information indicative of another portion of the received data to the responding one of the service providers.**"

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The Examiner argues that because, in FIGs. 5 and 6 of the Appellants' application, it is shown that an email with the buyer's identity is sent to the seller and the seller has to open and read the email, this is not automatic. Thus, the Examiner seemingly contends that the specification of the appellants' application does not support the claims even though this rejection was never made. However, it must be pointed out that the claims recite that the identity of the buyer is automatically provided to the agent without action by the agent, not that the agent automatically receives the identity. Clearly, this is not the same as having to specifically request additional information which has then to be formulated and sent back to the seller, as is taught in Rizzo.

2.   No Motivation to Combine/Destruction of Function.

The Appellants have taken a position that there is no motivation to modify the Burge teachings with those of Rizzo because such a combination would destroy the stated function of the Burge invention.

More particularly, Burge teaches a system for customizing content and presentation of content for computer users. The system monitors and records a user's navigational choices to determine the user's needs and preferences for subsequent computer displays. The functions of data collection and display customization are performed automatically by the electronic shopping system to allow the display of the products of many merchants' items from which the buyer can choose. If the user does not show a preference for a particular merchant's types of goods, this merchant's goods will never be displayed to the buyer. Burge does not allow for a merchant to directly contact a buyer to try to get them to buy their goods. And Burge does not allow the seller to select the buyer he wishes to do business with. In Rizzo the data collection functions are manual as the user specifies the desired criteria and they are not inferred. Rizzo allows the seller to select and contact the buyer if the seller is willing to provide the buyer

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goods/services after taking action to retrieve the buyer's contact information. Therefore, modifying Burge with the Rizzo teachings would destroy the Burge invention's function of allowing the buyer to select from many sellers based on the user's preferences (and not the other way around where the seller selects from many buyers). Furthermore, modifying Burge with Rizzo would also destroy Burge's automated function by the substitution of manual actions required by Rizzo for matching a buyer to seller (e.g., the displays could no longer be updated based on the inferred criteria of the buyer using the predictive model).

In response to this argument, the Examiner contends "the test for obviousness is not whether the features of the secondary reference may be incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." While this general statement of law is true, it does not apply when the proposed modification renders the prior unsatisfactory for its intended purpose. This is not only the view of the applicable case law, but of the U.S. Patent & Trademark Office as well, as expressed in MPEP Section 2143.02 (page 2100-127, Rev. 1, Feb. 2003) where under the heading "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE" it is stated:

> "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification".

Clearly, modifying Burge with the Rizzo teachings would destroy the Burge invention's function of allowing the buyer to select from many sellers based on the user's preferences (and not the other way around where the seller selects from many buyers). Furthermore, modifying Burge with Rizzo would also destroy Burge's automated function by the substitution of manual actions required by Rizzo for matching a buyer to seller (e.g., the displays could no longer be updated based on the inferred criteria of the buyer using
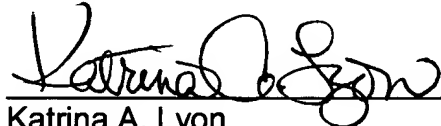
the predictive model).

It is noted that the Examiner also contends that "while the Appellant argues that Burge does not allow the seller to "select" the buyer he wishes to do business with, the claim language does not include any limitations such as "select". However, the Appellant's argument is directed toward incompatible teachings of Burge and Rizzo. The claim language is not at issue in this argument.

For the foregoing reasons, it is respectfully submitted that the Examiner's rejection of Claims 1-27 was erroneous. As such, reversal of the Examiner's decision is respectfully requested at the earliest opportunity.

Respectfully submitted,

Lyon & Harr, LLP
300 Esplanade Drive, Suite 800
Oxnard, California 93036
(805) 278-8855

Katrina A. Lyon
Registration No. 42,821
Attorney for Appellants